APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,486	02/28/2002	Jan Gerard Snip	PTT-136/CIP	5726

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EXAMINER
HASHEM, LISA

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.		icant(s)	
Office Action Summary	10/085,486		SNIP ET AL.	
	Examiner		Art Unit	
	Lisa Hashem		2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 February 2002</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>28 February 2002</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)   4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .   6) ☐ Other: .

DETAILED ACTION

1.   Claims 1-23 are pending in this office action.

Drawings

2.   The proposed drawing correction and/or the proposed substitute sheets of drawings, filed

on February 28, 2002 have been objected. A proper drawing correction or corrected drawings are

required in reply to the Office action to avoid abandonment of the application. The correction to

the drawings will not be held in abeyance.

3.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because

reference characters "12" and "13" on page 7, lines 20-21 have both been used to designate e-

mail server. A proposed drawing correction or corrected drawings are required in reply to the

Office action to avoid abandonment of the application. The objection to the drawings will not be

held in abeyance.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

5.   Claims 1-7, 10-18, and 20-23 are rejected under 35 U.S.C. 102(b) as being clearly

anticipated by U.S. Patent No. 6,243,739 by Schwartz et al, hereinafter Schwartz.

        Regarding claim 1, Schwartz discloses a method of transferring a message stored in a

computer arrangement or server (Figure 1, 51) to a mobile device (Figure 1, 11), comprising:

transmitting an alert message from said computer arrangement to said mobile device via a first

mobile network (Figure 1, 1; column 3, lines 42-51; column 10, lines 22-34; column 10, line 56

– column 11, line 7; column 11, lines 15-23); transmitting said message stored in said computer

arrangement (Figure 1, 51) to said mobile device (Figure 1, 11) upon request from said mobile

device (see Abstract) via a second mobile network (Figure 1, 40).

Regarding claim 2, the method according to claim 1 mentioned above, wherein Schwartz

further discloses establishing an on-line connection between said computer arrangement and said

mobile device (Figure 1; column 3, lines 42-59).

Regarding claim 3, the method according to claim 1 mentioned above, wherein Schwartz

further discloses said first network (Figure 1, 1) inherently is arranged to utilize a first protocol

and wherein said second network (Figure 1, 40) is inherently arranged to utilize a second

protocol (column 3, lines 42-51).

Regarding claim 4, the method according to claim 3 mentioned above, wherein Schwartz

further discloses sending said message from said computer arrangement to a protocol translator

(inherently in computer, Figure 1, 31) using a third protocol (UDP/IP), translating said message

in said third protocol to a message in said second protocol before transmission to said mobile

device (column 5, lines 10-21; column 6, lines 54-64).

Regarding claim 5, the method according to claim 1 mentioned above, wherein Schwartz

further discloses said computer arrangement is inherently an e-mail server (Figure 1, 51; column

3, lines 47-51; column 7, lines 58-59).

Regarding claim 6, the method according to claim 5 mentioned above, wherein Schwartz

further discloses said message is inherently an e-mail message (see Abstract; column 7, lines 58-

59).

Regarding claim 7, the method according to claim 1 mentioned above, wherein Schwartz

further discloses said second protocol is inherently HDTP which resembles HTTP but is

optimized for use with remote devices like wireless telephones (column 5, lines 10-12).

Regarding claim 10, a method according to claim 1 mentioned above, wherein Schwartz

further discloses establishing an on-line connection between said computer arrangement and said

mobile device either automatically by said mobile device or by said mobile device after being

instructed to do so by a user of the mobile device (column 3, lines 42-59; column 7, lines 24-38).

Regarding claim 11, Schwartz discloses the communication system comprising a

computer arrangement or server (Figure 1, 51) inherently storing a message in a memory and

arranged to transmit said message to a switched-on mobile device (Figure 1, 11; column 3, lines

42-59), comprising: transmitting an alert message from said computer arrangement to said

mobile device via a first mobile network (Figure 1, 1; column 3, lines 42-51; column 10, lines

22-34; column 10, line 56 – column 11, line 7; column 11, lines 15-23); transmitting said

message stored in said computer arrangement (Figure 1, 51) to said mobile device (Figure 1, 11)

upon request from said mobile device (see Abstract); wherein the two transmissions belong (in

part) to the same physical network (see Figure 1: 1, 40; column 3, lines 42-51) via a second

mobile network (Figure 1, 40).

Regarding claim 12, a communication system according to claim 11 mentioned above,

wherein please see the rejection to the method in claim 2 above, to reject the system in claim 12.

Regarding claim 13, a communication system according to claim 11 mentioned above, wherein please see the rejection to the method in claim 3 above, to reject the system in claim 13.

Regarding claim 14, a communication system according to claim 13 mentioned above, wherein please see the rejection to the method in claim 4 above, to reject the system in claim 14.

Regarding claim 15, a communication system according to claim 14 mentioned above, wherein Schwartz further discloses said protocol translator is included in the computer (Figure 1, 31); wherein computer and computer arrangement (Figure 1, 51) may be located on same hardware (column 4, lines 27-31; column 5, lines 10-21; column 6, lines 54-64).

Regarding claim 16, a communication system according to claim 12 mentioned above, wherein please see the rejection to the method in claim 5 above, to reject the system in claim 16.

Regarding claim 17, a communication system according to claim 16 mentioned above, wherein Schwartz further discloses said message is inherently an e-mail stored at the e-mail server (see Abstract; column 7, 58-59).

Regarding claim 18, a communication system according to claim 12 mentioned above, wherein Schwartz further discloses the system comprises a gateway or computer (Figure 1, 31) between the computer arrangement (Figure 1, 51) and the first (Figure 1, 1) and second mobile networks (Figure 1, 40)

Regarding claim 20, a commun cation system according to claim 12 mentioned above, wherein Schwartz further discloses the system comprises at least one mobile device (Figure 1, 11; column 4, lines 32-42).

Regarding claim 21, a communication system according to claim 20 mentioned above, wherein Schwartz further discloses said mobile device (Figure 1, 11) is arranged to generate an

HTTP get message or HDTP "Service Request" upon receiving said alert message, via computer

(Figure 1, 31), either automatically or after having received an instruction to that effect from a

user of the mobile device (column 7, lines 24-57).

Regarding claim 22, a communication system according to claim 21 mentioned above,

wherein Schwartz further discloses said protocol translator is arranged to translate said message

to a HTTP or HDTP reply message (column 7, lines 58-66).

Regarding claim 23, Schwartz discloses a mobile device (Figure 1, 11) arranged to

receive an alert message through a first mobile network (Figure 1, 1; column 3, lines 42-51;

column 10, lines 22-34; column 10, line 56 – column 11, line 7; column 11, lines 15-23), to

automatically generate a HTTP get message or HDTP "Service Request", via computer (Figure

1, 31; column 7, lines 24-57), to transmit the HTTP get message to a computer arrangement or

server (Figure 1, 51) storing a message for the mobile device (Figure 1, 11) and to receive the

message from said computer arrangement or server (Figure 1, 51) as a HTTP reply message, via

computer (Figure 1, 31; column 7, lines 58-66).

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   Claims 8-9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6,243,739 by Schwartz et al, hereinafter Schwartz, as applied to claim 1 mentioned

above, and in further view of U.S. Patent No. 6,385,451 by Kalliokulju et al, hereinafter Kalliokulju.

Regarding claim 8, a method according to claim 1 mentioned above, wherein Schwartz fails to disclose said second wireless network is either GPRS or UMTS.

Kalliokulju discloses a method of transferring or downloading an email message inherently from a computer arrangement to a mobile device (see Abstract; Table 1, Fourth class), wherein there is a handover of a connection between a first and second mobile communication terminal comprising: a first and a second wireless network; wherein the second wireless network is either GPRS or UMTS and the second wireless network defines a traffic class for the data transmission connection (column 1, lines 28-37; column 2, lines 46-49; column 3, lines 35-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Schwartz to include a second wireless network that is either GPRS or UMTS as taught by Kalliokulju to allow the transmission of data. One of ordinary skill in the art would have been lead to make such a modification since a digital mobile phone system would use the GPRS packet transmission service or UMTS packet transmission service to transmit or download data, e.g. e-mail, to a mobile device.

Regarding claim 9, a method according to claim 1 mentioned above, wherein Schwartz fails to disclose said first wireless network is GSM.

Kalliokulju discloses a method of transferring or downloading an email message inherently from a computer arrangement to a mobile device (see Abstract; Table 1, Fourth class), wherein there is a handover of a connection between a first and second mobile communication terminal comprising: a first and a second wireless network; wherein the first wireless network is

GSM and the first wireless network comprises means for establishing a connection that is either

connection-oriented and/or connectionless (column 1, lines 28-37; column 1, lines 49-51;

column 2, lines 1-7).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the method of Schwartz to include a first wireless network that is GSM as

taught by Kalliokulju for establishing a data transmission connection. One of ordinary skill in the

art would have been lead to make such a modification since a digital mobile phone system, such

as the GSM system, would allow the transmission or download of data, e.g. e-mail, to a mobile

device.

Regarding claim 19, a communication system according to claim 18 mentioned above,

wherein Schwartz further discloses, in operation, the computer arrangement (Figure 1, 51), upon

inherently receiving said message, inherently establishes a PAP (standard authentication)

message and transmits this PAP message via a PAP protocol to said gateway (Figure 1, 31;

column 7, lines 58-59; column 8, lines 25-46), and the gateway (Figure 1, 31), upon receiving

said PAP message, generates a message for said mobile device (Figure 1, 11) including said alert

message (column 10, lines 22-34).

Schwartz fails to disclose generating a SMS message for said mobile device including

said alert message.

Kalliokulju discloses a method of transferring or downloading an email message

inherently from a computer arrangement to a mobile device (see Abstract; Table 1, Fourth class),

wherein there is a handover of a connection between a first and second mobile communication

terminal comprising: a first and a second wireless network; wherein the first wireless network is

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GSM and the first wireless network comprises means for establishing a connection that is either connection-oriented and/or connectionless (column 1, lines 28-37; column 1, lines 49-51; column 2, lines 1-7). Wherein, a SMS message is generated for said mobile device (column 1, line 49 – column 2, line 7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Schwartz to include a first wireless network that is GSM and generating a SMS for said mobile device as taught by Kalliokulju for establishing a data transmission connection. One of ordinary skill in the art would have been lead to make such a modification since a digital mobile phone system, such as the GSM system, would allow the transmission or download of data, e.g. e-mail, to a mobile device and the GSM system provides a short message service that resembles a paging system, wherein a SMS is generated for said mobile device.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 5,771,353 by Eggleston et al disclose a method of transferring a message stored in an electronic post office to a mobile device via a communications server

9.   Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for formal communications intended for entry)

Or call:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

10.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh
January 15, 2004

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